

SEP 26 2005

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through 10/30/2005. OMB 0651-0001
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P166 1010.1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 26, 2005</u> Signature <u>[Signature]</u> Typed or printed name <u>Diana Ogles</u>		Application Number <u>09/759,103</u>	Filed <u>January 12, 2001</u>
		First Named Inventor <u>Clark</u>	
		Art Unit <u>3622</u>	Examiner <u>Daniel Lastra</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. <u>32,497</u> Registration number <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>[Signature]</u> Signature <u>John J. Timar</u> Typed or printed name <u>(404) 888-7412</u> Telephone number <u>September 26, 2005</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9169 and select option 2.

BEST AVAILABLE COPY

SEP 26 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:) Examiner: Daniel Lastra
Clark, et al.) Group Art Unit: 3622
Serial No: 09/759,103) Confirmation No.: 1839
Filed: January 12, 2001) Attorney Docket No.: P166 1010.1
For: Search Engine Providing an Option to Win the Item Sought

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Final Office Action mailed June 27, 2005, for the above-identified patent application, Applicants submit the following arguments in conjunction with this Pre-Appeal Request for Review.

The Examiner's rejection of claims 1, 2, 7-10, 12-15, 17-25 and 27 under 35 U.S.C. 103(a) as unpatentable over *Walker, et al.* (U.S. 2003/0054888) in view of *Ghouri, et al.* (2002/0082978) is in error.

The Examiner's ability to use either the *Walker, et al.* or the *Ghouri, et al.* published applications is predicated on the fact that both claim priority to provisional patent applications that were filed before Applicant's patent application was filed on January 12, 2001. In order to use either of these references as prior art based on earlier filed provisional applications, the provisional applications themselves must teach that which the Examiner relies upon for showing aspects of the Applicants' claimed invention in the published applications of *Walker, et al.* and *Ghouri, et al.* It is an error for the Examiner to rely on teachings of the published applications that were not also in the provisional applications from which the published applications claim priority.

BEST AVAILABLE COPY

ATLANTA 468151v1

1

Regarding claim 10, the Examiner stated at page 3 of the office action mailed June 27, 2005 that *Walker* teaches "automatically transmitting electronic signals representing at least a first option for the user to play a game to win the product without the user first making any payment (citing *Walker*, paragraph 130) or requesting the first option and a second option to purchase the product" (citing *Walker*, paragraphs 34, 149). Applicants' arguments are found in the amendment response filed March 30, 2005 at pages 15-16. Specifically, Applicants argue that the statement in *Walker, et al.* provisional patent application 60/204,763, that the customer may be able to play for free for a limited number of plays (alternate method and use 13 on page 6 of 8) does not constitute a teaching of this particular claim step.

This isolated statement does not constitute a teaching or suggestion of an automatically transmitted option to play a game to win a product without making any payment or first requesting the option. Figs. 6, 7 and 9 in the *Walker* provisional application each show the step of receiving payment or a wager before executing the game. Fig. 8 does not explicitly show a step of payment, but the text describing the point-of-sale (POS) view depicted in this figure states at item 3 on page 8 of 8 that "If the product has been won, provide for no additional payment, otherwise credit towards payment at least some portion of the amount previously spent by the customer when trying to win the product."

Furthermore, the Examiner cannot rely on the teachings of paragraph 130 of the *Walker, et al.* published application which describes alternate forms of entry into a game since there are no counterpart teachings in the *Walker* provisional application. However, even if these teachings could be applied, the alternate forms of entry into a game to play for a product that are described in paragraph 130 are not a teaching or suggestion of automatically transmitting electronic signals representing an option to play to win a product without first requesting an option to play. Therefore, it was an error to use the teachings of this paragraph in the rejection of claim 10.

Applicants' arguments concerning the teachings of paragraph 149 are found on page 16 of Applicants' March 30, 2005 amendment response. As noted therein, *Walker* teaches that the customer pays for the product before playing a game to win the same product. In the related flowchart of Fig. 10, there is no depiction of directing a customer to a web site to buy a product. As shown in Fig. 10, the customer pays for the product, then requests to play the game to win the

product. However, even the step of requesting to play the game is not depicted in the flow charts or specification of the provisional application. Therefore, it was an error to use the teachings of this paragraph in the rejection of claim 10.

Further regarding claim 10, the Examiner stated at page 3 of the Office Action mailed June 27, 2005, that *Walker* teaches "if user chooses to purchase a product instead of playing the game: directing the user to a website which sells the product," citing *Walker* paragraphs 34, 149 – 151. Applicant's arguments are found in the Amendment response filed March 30, 2005, at pages 16 – 17. As noted therein, paragraphs 149 – 151 and Fig. 10 of *Walker, et al.* describe a process in which a customer selects a product, payment is received for the product, and the customer requests to play a game for the product.

In paragraph 150, *Walker, et al.* teaches that selection of the product is received by a POS terminal in response to a bar code scanner scanning a bar code corresponding to the product. Paragraph 151 teaches that payment for the product is received using a payment identifier associated with the customer identifier received by the customer input/output device or through manual input by the customer using the customer input/output device. As shown in Fig. 10 of *Walker, et al.*, after a customer selects and pays for the product, he then requests to play a game to either win the product or have a portion of the fee for playing the game credited to the customer. There is no teaching in *Walker, et al.* of directing the user to a website that sells a product if a user chooses to purchase a product instead of playing the game when presented with the alternative options. In Applicants' invention, the user has the selectable options to win the product or to buy the product. If the user decides to buy the product, a hyperlink takes the user to the product provider's website in order to purchase the product.

With further regard to the teachings of paragraphs 149 – 151 of *Walker, et al.*, the closest corresponding teachings are found in the provisional application in Figs. 8 – 9, the corresponding description of Fig. 9 on page 7 of 8 of the provisional application, and the description of the POS view on page 8 of 8 of the provisional application. Note that the description of Fig. 9 is "a flow chart of the exemplary method performed by the control program in an embodiment where the customer purchases the item the customer wishes to win before trying to win the item." There is no teaching in the *Walker, et al.* provisional application of the customer actually requesting an

BEST AVAILABLE COPY

option to play the game. Therefore, it was an error to use the teachings of these paragraphs in the rejection of claim 10.

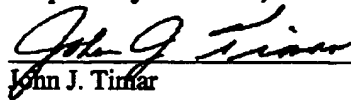
Claims 1, 15, 21 and 22 each include the limitation of automatically providing the user with an option to play the game to win a selected product or service without the user first making any payment or requesting the option. The Examiner used the same basis for rejecting these claims as he did for claim 10. As argued above, it was an error for the Examiner to apply the teachings of the *Walker, et al.* published patent application for teachings that were not found in the provisional patent application. Therefore, the rejections of claims 1, 10, 15, 21 and 22 are each based on teachings in the *Walker, et al.* published application that are not found in the provisional patent application.

Further regarding claim 1, the Examiner stated at page 4 of the Office Action mailed June 27, 2005, that *Ghourl, et al.* teaches "transmitting electronic signals representing dealers in the product or service and associated prices. The Examiner stated that *Ghourl, et al.* teaches a system that searches for dealers of products selected by users, citing paragraphs 22 and 23. Applicants' arguments concerning *Ghourl, et al.* are found at page 18 of the Amendment response filed March 30, 2005. Although Applicants' arguments were made with respect to the Examiner's rejection of claim 20, they are also applicable to claims 1, 15 and 21. *Ghourl, et al.* teaches an interactive system which provides customers with comprehensive information about a plurality of products and any associated customizable features, further providing a forum for conducting a reverse auction where sellers of products, exactly or closely matching those sought by the customer, bid for that customer's business (paragraph 22). *Ghourl, et al.* further teaches an interactive system and method for customizing an automobile through an interactive, online automobile configuration program, which may be electronically integrated and configured with dealers' inventory, and subsequently soliciting bids for the customer's automobile from a plurality of automobile dealerships over a distributed computing network (paragraph 23). As stated in paragraph 66, requests for new bids are transmitted, preferably with electronic mail, to notify the system support group and the participating dealers. Dealers can access the system of *Ghourl, et al.* and submit a bid that the customer can consider. The customer must select a bid before receiving dealer contact information (paragraph 74). Fig. 20 illustrates a sample bid results page;

Fig. 21 illustrates a bid comparison page; Fig. 22 illustrates the bid acceptance page. Only after accepting a bid does the customer obtain any dealer information. This does not represent a teaching of transmitting electronic signals representing dealers in the product or service and associated prices as claimed in claim 1. Therefore, it was an error to apply the teachings of *Ghourl, et al.* directed to a reverse auction for a customizable product in rejecting claim 1. Claims 15 and 21 both include the limitation of transmitting electronic signals representing a plurality of dealers and associated prices charged by each of the dealers. Therefore, for the same reasons as for claim 1, it was an error for the Examiner to apply the teachings of *Ghourl, et al.* in the rejection of claims 15 and 21. The Examiner has also failed to provide copies of the twelve web pages and thirty-five page technical description that are part of the *Ghourl, et al.* provisional application. Thus Applicants are unable to ascertain which teachings of the *Ghourl, et al.* published application can be applied as prior art.

In view of the above, it is submitted that the Examiner's rejection of independent claims 1, 10, 15, 21 and 22 was in error because it was based on the *Walker, et al.* published patent application filed after the present application, and relying on teachings not found in the corresponding provisional patent application and consequently not applicable as prior art. Furthermore, it was an error to apply the teachings of *Ghourl, et al.* in the rejection of Claim 1, 15 and 21, since *Ghourl, et al.* does not teach transmitting electronic signals representing dealers in the product or service and associated prices.

Respectfully submitted,



John J. Timar
Registration No. 32,497
Attorney for Applicants

9/26/05
Date
Womble Carlyle Sandridge & Rice, PLLC
P.O. Box 7037
Atlanta, GA 30357-0037
(404) 888-7412 (Telephone)
(404) 870-2405 (Facsimile)

BEST AVAILABLE COPY